

### REMARKS

Applicant acknowledges receipt of the Final Office Action dated November 4, 2005 ("the Action"). In the Action, the Examiner rejected claims 1-82. Although the Examiner acknowledged that failure to claim "linking claims" is error properly correctable through reissue, the Examiner concluded that claims 13-82 are not linking claims because Applicant's pending claims are not "broad enough to read on the invention elected (and patented) together with the invention not elected." See Action at 2. Further, the Examiner concluded that *In re Doyle*, 293 F.3d 1355 (Fed. Cir. 2002) applies only to linking claims: "[S]ince the reissue claims are not corresponding to linking claims, consequently, there is no error present or relied upon to support the reissue application, and the patent therefore will not be reissued." See id.

Because Applicant believes the Examiner did not fully appreciate Applicant's arguments, Applicant respectfully requests the Examiner's reconsideration.

#### Summary

It is respectfully submitted that the reissue claims are the proper subject of a reissue proceeding for the following reasons:

(1) Currently pending reissue claims 13-82 are linking claims. "Linking claims" are not limited to claims broad enough to read on both the elected and non-elected claims; instead, as provided in MPEP 809, linking claims are "one or more claims . . . inseparable [from the elected and non-elected claims] and thus linking together the otherwise divisible inventions." Claims 13-82 satisfy this requirement even though they are not the "genus" type of linking claims at issue in *In re Doyle*. In fact, pending reissue claims 13-82 appear to qualify as "subcombination claims linking plural combinations," a separate type of linking claim expressly recognized by the MPEP. MPEP § 809.

(2) Although a failure to pursue "genus" type linking claims is certainly one type of error correctable by reissue under *In re Doyle*, it is not the only type. Instead, by its own terms, *In re Doyle* applies any time (1) the reissue claims are not "substantially similar" to the claims corresponding to non-elected subject matter and (2) the pending reissue claims could have been pursued alongside the originally issued claims. Pending claims 13-82 qualify under *In re Doyle*.

(3) Even if the Examiner concludes that pending claims 13-82 are not linking claims and are instead directed to a "separate and distinct" invention, 37 C.F.R. § 1.176(b) authorizes the

Examiner to issue a restriction requirement so that Applicant may pursue these claims in a divisional reissue application.

**Factual Background and Nature of the Reissue Claims**

In the original prosecution, a four-way restriction requirement was entered. The first group of species was elected (the "Elected Group") without traverse and the claims corresponding to the other groups (the "Non-Elected Groups") were cancelled. The claims corresponding to the Elected Group issued as claims 1-12 but the claims corresponding to the Non-Elected Groups were not pursued in a divisional application. Pending reissue claims 13-82 are not directed to the Elected Group or the Non-Elected Groups *per se*. Instead, these claims include limitations directed to both the Elected Group and the Non-Elected Groups. See 07/25/2005 Response at pages 26-28. These claims are therefore hybrid claims that were neither considered during the original prosecution nor surrendered by the Applicant. Under the Rules and case law recited below, such hybrid claims are the proper subject of a reissue application.

- A. **Claims 13-82 are "linking claims" because, as provided by the MPEP (and case law), they "link[] together the inventions" corresponding to the elected and non-elected groups.**

Applicant agrees with the Examiner that claims "broad enough to read on the invention elected (and patented) together with the invention not elected" are linking claims. Applicant respectfully disagrees, however, that such claims are the only type of linking claim. The MPEP provides explicitly that linking claims are any type of claim that link together otherwise divisible subject matter and thereby render the otherwise divisible subject inseparable:

There are a number of situations which arise in which an application has claims to two or more properly divisible inventions, so that a requirement to restrict the claims of the application to one would be proper, but presented in the same case are one or more claims (generally called "linking" claims) inseparable therefrom and thus linking together the otherwise divisible inventions.

MPEP 809. Just as the "genus" claims at issue in *In re Doyle* linked the subject matter of the elected and non-elected groups, so too do the hybrid claims here, which include limitations from both the Elected and Non-Elected Groups.

The MPEP goes on to identify the "most common type of linking claims" as including, but not limited to, "genus claims linking species claims" such as those at issue in *In re Doyle*:

The most common types of linking claims which, if allowable, act to prevent restriction between inventions that can otherwise be shown to be divisible, are

(A) genus claims linking species claims; and

(B) subcombination claims linking plural combinations.

*Id.* (emphasis added). Clearly, the concept of a “linking claim” is a broad term—far broader than the type at issue in *In re Doyle*—and extends to narrower “subcombination claims” that link otherwise divisible combinations (such as those here).<sup>1</sup>

The courts, like the MPEP, have endorsed this broad reading of the term “linking claim.” Indeed, the courts have characterized claims like those here—namely, hybrid claims that include limitations corresponding to more than one group of restricted claims—as “linking claims”:

*In re Freeman, supra*, is a case where the examiner had divided the claims of the application into five groups and required division between those groups. . . . In its supplemental decision therein, the board selected claim 40 as representative of claims 37-42, and held that it included a specific improvement in winding and unwinding means set forth in certain group 1 claims and also specific safety means recited in groups 4 and 5. The board considered claims 37-42 as ‘linking claims’ . . . . The presence of the linking claims did not prevent this Court from affirming the requirement of division.

*In re Brouwer*, 175 F.2d 564, 568 (C.C.P.A. 1949) (emphasis added). Simply put, claims that tie together the elected and non-elected groups (as described in MPEP 809) are linking claims irrespective of whether they are broad genus claims (as described in *In re Doyle*) or narrower hybrid claims (as described in *In re Brouwer* and *In re Freeman*).

Because pending reissue claims 13-82 are linking claims and because the Examiner recognized that failure to pursue linking claims is error correctable through reissue, the Examiner’s rejection is improper and Applicant respectfully requests that it be withdrawn.

**B. Pending reissue claims 13-82 satisfy the *In re Doyle* test.**

Although reissue claims 13-82 are not the same type of linking claims analyzed in *In re Doyle*, the straightforward application of that case to the present facts leads inescapably to the

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<sup>1</sup> In addition, there are yet other kinds of “linking claims,” as reflected in section 809.03 of the February 2003 revision of the original Eighth Edition of the MPEP. MPEP (8<sup>th</sup> Ed. 2003) 809.03 (recognizing at least four different categories of linking claims) (attached as Exhibit “A”).

conclusion that Applicant's oversight in failing to pursue reissue claims 13-82 during the original prosecution was error correctable by reissue.

In *In re Doyle*, the applicant filed claims corresponding to several species. See 293 F.3d at 1356. Following a restriction requirement, Doyle elected one species without traverse and failed to pursue the non-elected claims in a divisional application. See id. During reissue, he did not seek to pursue the non-elected claims. Instead, Doyle sought to claim the genus encompassing the species corresponding to the elected and non-elected groups. See id. at 1357. The issue was whether the failure to pursue such a genus claim during the original prosecution was error correctable by reissue. See id. at 1358.

The Federal Circuit's analysis began with the premise—equally applicable here—that “[t]he [reissue] statute is remedial in nature, based on fundamental principles of equity and fairness, and should be construed liberally.” *Id.* The court noted that the statute applies “to situations in which an error occurred—situations that include the patentee having claimed more or less than he had a right to claim in the patent.” *Id.* (internal quotations omitted). Because Doyle's claims differed in scope from his issued claims, Doyle's reissue application claims “come squarely within the mandate of section 251.” *Id.* Here, too, reissue claims 13-82 clearly differ in scope from the originally issued claims. Thus, as a threshold matter, Applicant's reissue claims—like Doyle's—come squarely within the mandate of section 251.

The Board in *In re Doyle* (like the Examiner here) viewed Doyle's claims as precluded under the *In re Orita* doctrine, which provides that failure to pursue non-elected claims in a divisional application is not error correctable by reissue. The Federal Circuit rejected the Board's conclusion because “the rationale underlying *In re Orita* and the holding of that case extend only to claims that are identical to or of substantially similar scope to those of the nonelected group.” *Id.* at 1361 (emphasis added). In short, *In re Orita* simply does not apply so long as the reissue claims are not “substantially similar” to the claims of the non-elected group(s). Here, pending reissue claims 13-82 are decidedly not “substantially similar” to the claims of the non-elected groups. Indeed, the Examiner has not contended that they are. Rather, as explained above and as evident from the claims themselves, reissue claims 13-82 are linking claims that include limitations from both the

Elected Group and the Non-Elected Groups (and are therefore different in scope than the claims corresponding to either the Elected Group or the Non-Elected Group).<sup>2</sup>

Although the reissue claims in *In re Doyle* were genus claims, the Federal Circuit did not narrowly tailor its analysis to such broad claims. To the contrary, the Federal Circuit spoke more generally, rejecting outright the PTO's position—the same position the Examiner has adopted here—that acquiescence to a restriction requirement “forecloses the applicant's right to assert claims in reissue to any portion of the subject matter of the nonelected groups.” *Id.* The court held that this was “too broad a view of *In re Orita*.” *Id.* Here, Applicant's hybrid linking claims recite a “portion of the non-elected groups” in conjunction with a portion of the elected group. For the same reason as in *In re Doyle*, *In re Orita* does not apply here.

The *In re Doyle* court also found compelling another factor that is equally applicable here: like *Doyle*, Applicant “could have prosecuted his reissue claims with the claims of the elected group”:

There is another critical, and indeed dispositive difference between the present case and *In re Orita*: Dr. Doyle could have prosecuted his reissue claims with the claims of the elected group. Indeed, as the Solicitor concedes, these linking claims not only could have but *should have* been prosecuted with the elected group. This undercuts the other, more important rationale of *In re Orita*: that the issued patent contains no error. This second rationale underlying the result in *In re Orita* turned on the fact that the applicant could not have asserted the new reissue claims with the elected group. The reason, of course, was the restriction requirement—the examiner specifically required *Orita* to prosecute those claims in a different application. In contrast, Dr. Doyle could have prosecuted his claims with the elected group without

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<sup>2</sup> *In re Weiler*, 790 F.2d 1576 (Fed. Cir. 1986) is similarly inapplicable here. That case—unlike the present one—dealt with reissue claims that were directed to a wholly separate invention (*i.e.*, not linking claims). *Id.* at 1581. Here, in contrast, the reissue claim limitations were present in the combination of the Elected and Non-Elected Groups. Further, unlike Applicant's reissue claims, *Weiler*'s reissue claims were not well supported by the written description. *Id.* Law subsequent to *In re Weiler* has made clear that the rubric of “intent to claim” is limited to whether the reissue claims are supported by the original written description or whether they introduce new matter:

[T]he purpose of the rubric “intent to claim” is to ask the same question as to whether “new matter” has been “introduced into the application for reissue” thus, perforce, indicating that the new claims are not drawn to the same invention that was originally disclosed.

*In re Amos*, 953 F.2d 613, 618 (Fed. Cir. 1991).

running afoul of the restriction requirement because they are linking claims. See *Manual of Patent Examining Procedure* § 809.03 (8th ed. 2001) ("MPEP").

*Id.* at 1360 (emphasis added). As recognized by the *In re Doyle* court, an Applicant is always free to prosecute linking claims alongside the elected group.

Both the MPEP and the case law recognize that an applicant has the right to prosecute linking claims alongside the claims to an elected group. Indeed, the MPEP provides not only that an applicant can proceed with an elected group and linking claims, but also that the applicant is entitled to also pursue the non-elected claims if the linking claims survive scrutiny. MPEP 809 ("The linking claims must be examined with, and thus are considered part of, the invention elected. When all claims directed to the elected invention are allowable, should any linking claim be allowable, the restriction requirement between the linked inventions must be withdrawn."). The Court in *In re Brouwer* (cited above) also recognizes that an applicant is entitled to prosecute linking claims alongside the elected group and indeed may force review of the claims corresponding to the non-elected groups if the linking claims are found patentable. 175 F.2d at 568-69.

**C. 37 C.F.R. 1.176(b) Is Inconsistent with the Examiner's Rejection.**

Implicit in the Examiner's rejection is the notion that a reissue application may never include claims to inventions distinct from the originally claimed invention. Applicant respectfully disagrees. Following *In re Orita* and *In re Weller*, 37 C.F.R. § 1.176 was rewritten to make clear that reissue applications may include inventions distinct from the originally claimed inventions:

Restriction between subject matter of the original patent claims and previously unclaimed subject matter may be required (restriction involving only subject matter of the original patent claims will not be required). If restriction is required, the subject matter of the original patent claims will be held to be constructively elected unless a disclaimer of all the patent claims is filed in the reissue application, which disclaimer cannot be withdrawn by applicant.

37 C.F.R. § 1.176(b). The history of this regulation reflects that subsection (b) was added "to eliminate the prohibition against requiring division in a reissue application." 65 FED. REG. 54604. Rule 176(b), therefore, now allows an examiner to make a restriction requirement in a reissue application between "subject matter of the original patent claims and **previously**

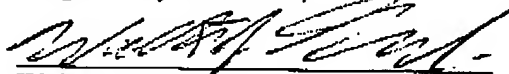
**unclaimed subject matter.”** 37 C.F.R. § 1.176(b). (emphasis added). MPEP 1450 further states that Rule 176(b) “permits the examiner to require restriction in a reissue application between claims newly added in a reissue application and the original patent claims, where the added claims are directed to an invention which is separate and distinct from the invention(s) defined by the original patent claims.” *Id.* Thus, even if the Examiner determines that pending reissue claims 13-82 are not linking claims, they are nevertheless authorized under 37 C.F.R. § 1.176(b).

Here, the Examiner states that the subject matter of the reissue claims offered in the present application “is independent and distinct from the subject matter of the elected and patent claims.” See Reissue Office Action dated March 8, 2005 at 3. For the reasons given above, Applicant respectfully disagrees and asserts that the claims are linking claims. Nevertheless, even if the Examiner is correct, the pending reissue claims fall squarely with Rule 176(b) and must be examined. If the Examiner concludes that the pending claims are indeed directed to a separate and distinct invention, the Examiner is free to issue a restriction requirement between the originally issued patent claims and the reissue claims. The original patent claims will then be held to be constructively elected, while the non-elected, newly added reissue claims are held in abeyance in a withdrawn status and only examined if filed in a divisional reissue application pursuant to 37 C.F.R. § 1.177.

### **CONCLUSION**

Applicant respectfully requests reconsideration of the pending reissue claims. If the Examiner feels that a telephone conference would expedite the resolution of this case, he is respectfully requested to contact the undersigned.

Respectfully submitted,



Walter J. Tencza Jr.  
Attorney for the Applicant  
Reg. No. 35,708  
Suite 3  
10 Station Place  
Metuchen, N.J. 08840  
Phone: 732-549-3007  
Fax: 732-549-8486